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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,002	04/25/2001	Yuji Kishida	81870.0018	7882

26021 7590 11/18/2003

HOGAN & HARTSON L.L.P.  
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LOS ANGELES, CA 90071-2611

EXAMINER
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ULLAH, AKME

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/843,002	KISHIDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Akm Enayet Ullah	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-19 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Detailed Action***

Applicant cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Status of the Application***

Claims 1-19 are pending in this application

Claims 6 -19 are allowed over the prior art as of record.

Claims 1-5 are rejected under new grounds of rejection

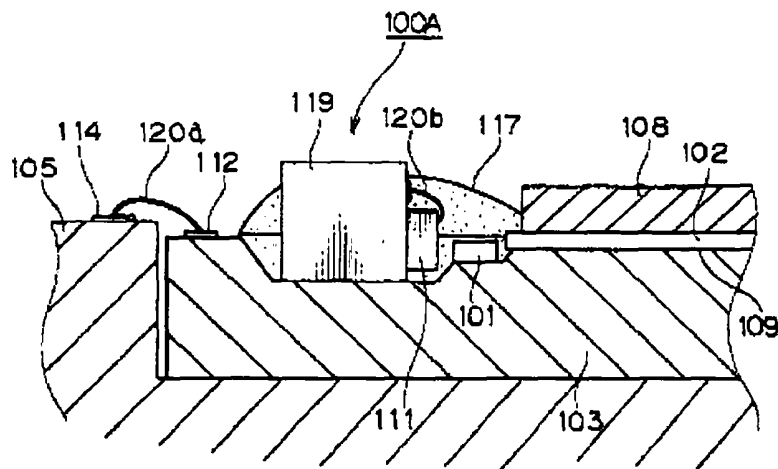
***Claim Rejections - 35 USC § 103***

***The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.***

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setoguchi (USPNO. 6,467,972) in view of Saito (USPNO. 6,377,385).

Figure 7 describes the instant invention as claimed in claim 1- 5.

FIG. 7



Setoguchi disclose an optical interconnection module and mounting structure thereof by which an optical fiber and an optical semiconductor device can precisely be interconnected to realize a reliable interconnection in a long term.

The module comprises a first mounting base member and a second mounting base member. At least an optical semiconductor device and an optical fiber interconnected to optical semiconductor device are held on the first mounting base member. The first mounting base member with the optical semiconductor device and the optical fiber is further fixed on the second mounting base member

Regarding claim 4, a surface of single crystalline silicon and the positioning face corresponds to surface equivalent to surface of the single crystalline silicon, which is mentioned in column 11 of the reference (third paragraph).

Note that the use of electrode in this type of device is an inherent of the reference. For details see column 17-18 of the reference.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such optical module system which would provide a high productivity, downsized and splendid high frequency characteristic wherein optical semiconductor device mounted on the carrier can be optically coupled with the optical fiber mounted on the substrate.

Setoguchi reference may not teach explicitly a positioning face slanted by a predetermined angle as claimed in claim 1. But this type of positioning face is very elementary teaching in the art as is shown by Saito reference.

It would have been obvious to one of ordinary skill in the art at the time invention was made to use such poisoning face which is slanted by a predetermined angle of Saito in Setoguchi reference for the semiconductor device claimed in claims 1-5 since, both references being directed to a common use in the same environment, there is an implied suggestion for applying that teachings of one to the other. That is, skilled worker who is pressured to have knowledge of the prior art, with these two references before him, would immediately recognize the desirability of employing the positioning face taught by Saito to the semiconductor device of Setoguchi, as claimed.

***Allowable Subject Matter***

Claims 6-19 are allowed over the prior art as of record.

***Arguments Are Moot Because Of New Ground Of Rejection***

Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new grounds of rejection.

***Cited Prior Art***

The use of positioning face slanted by a predetermined angle in a semiconductor device along with a mounting face are also cited by Yoneda et al, Masuda et al, Furuyama and Sasaki et al respectively.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akm Enayet Ullah whose telephone number is 703-308-4885. The examiner can normally be reached on Mon.- Wed. 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 703-3084819. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7721 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A handwritten signature in black ink, appearing to read 'Akm Enayet Ullah', with a long horizontal flourish extending to the right.

Akm Enayet Ullah  
Primary Examiner  
Art Unit 2874

AUllah  
November 12,2003